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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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WAYNE J COLTON INC
THE MILAM BUILDING SUITE 1108
115 EAST TRAVIS STREET
SAN ANTONIO TX 78205

EXAMINER

REMITTANCE

ART UNIT

PAPER NUMBER

3764

DATE MAILED:

06/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/432,904

Applicant(s)

LINA, CESAR Z.

Examiner

Danton DeMille

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 20) ☐ Other:

DETAILED ACTION

Specification

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention.

3. At the top of page 8, it is recited "although each of the sheets 2 and 3 are air impermeable, they are each also formed of vapor permeable fabric". It is not clear how the fabric can be air impermeable and also be vapor permeable. It would seem that if the fabric is air impermeable that it would also be vapor impermeable.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

6. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-19 are rejected under the judicially created doctrine of double patenting over claims 1-4 of U. S. Patent No. 5989204 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

8. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both applications claim a medical device adapted for use with cyclical application of fluid pressure to apply said pressure to a human foot, comprising an interior elastic fabric sheet, a non-extensible exterior flexible sheet and a bladder formed between the two sheets.

9. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

10. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 5989204. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to leave out details of the tabs for releasably securing the foot wrap.

Claim Rejections - 35 USC § 112

11. **Claims 1-7 and 11-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not adequately described as set forth in the above objection to the specification.** It is not clear what is intended to comprehend the limitations of the sheets comprising a vapor permeable construction.

12. **Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

13. In lines 9-10 of claim 1, it is recited that the foot wrap comprises an inflatable bladder at an interior side of the exterior sheet however, lines 7-8 just before it said that the foot wrap is the joining of the exterior sheet to the interior sheet. These two limitations would appear to contradict themselves. It is not clear how the foot wrap can be both.

14. It is not clear what structure or means provides the limitation of lines 11-13 of claim 1.

What structure or means of the interior sheet provides this function? How does this language further define the structure of the interior sheet?

15. Claim 2 recites the inflatable bladder comprising at least a portion of the interior sheet however, claim 1 has already recited that the inflatable bladder is at an interior side of the exterior sheet. It is not clear how the bladder is both.

16. Claim 3 also appears to contradict claim 1 in that claim 1 recites the bladder as being "at an interior side of said exterior sheet" which would imply that the bladder is something other than the exterior sheet. Claim 3 recites that the bladder is made up of the exterior sheet.

17. In claims 11-19 there is some confusion between different parts containing the hook-type connector. Claim 11 recites the exterior sheet consists of a hook-type connector and then the tabs also contain the hook-type connector. It is not clear how they both can contain the hook-type connector. At least one of them would have to contain the loop-type connector in order for the hook and loop connector to work. As understood, the exterior sheet contains the loop-type connector to mate with the hook-type connector of the tabs.

18. In line 11 of claim 11, it is not clear what structure is being referred to by "thereof". Is it the distal end of the inner surface or the first tab?

19. To any extent the claims are understood the following appears to be appropriate.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:


(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. **Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dye '044 in view of Arkans '217.** Dye teaches a medical device adapted for cyclical application of fluid pressure to a human foot including an interior sheet 22 and an exterior sheet 14. The inner sheet 22 is sealed to the periphery 23 of outer sheet 14. The outer sheet is recited as "an outermost flexible fluid-impervious sheet 14, made of urethane-coated nylon, or the like", column 3, lines 30-32. It is also recited that "the outermost sheet is stiffer and inelastic relative to the inner most film". This would imply the inner sheet is more flexible and elastic than the outer sheet. While Dye may be silent as to whether or not the inner sheet is also made of fabric such is well known. Arkans teaches that both the inner sheet and outer sheet can comprise fabric. It is also well known that the inner sheet is intended to be elastic in order to expand and apply pressure to the body while the outer sheet remains inelastic so as to direct the expansion inwardly toward the body. It would appear the elastic nature of the inner sheet would maintain the bladder wrinkle free because it is elastic and would return to its original shape. It would have been obvious to one of ordinary skill in the art to modify Dye to have the more elastic inner sheet comprise fabric as taught by Arkans to present a soft breathable material next to the skin.

22. **Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kartheus et al. in view of Frajderrajch.** Kartheus teaches a medical device adapted for use with cyclical application of fluid pressure to apply pressure to a human foot comprising outer

fabric sheets 14 and an inner bladder 13. While Kartheus teaches a separate bladder on the inside of a fabric pocket, it would have been obvious to simply the wrap by making wrap comprise single inner and outer layers bonded together forming bladders. Frajderrajch teaches such a convention in lines 21-38 column 4. Frajderrajch teaches two flexible walls 6 and 7 to which are inserted inflatable pockets 8 made of elastic material. Frajderrajch goes on to teach "the accessory may simply be formed by two walls sealingly welded together in appropriate places to form the cells". As suggested by Frajderrajch it would be obvious to take the fabric cover with inflatable pockets and form it as two impervious fabric layers welded together at appropriate locations to form inflatable pockets. Such would have been an obvious provision in the foot wrap embodiment of Kartheus. Since it is also well known that the outer fabric sheet be stiffer and more inelastic than the inner sheet so that the expansion of the bladder is directed inward toward the body rather than outward away from the body. It would have been obvious to one of ordinary skill in the art to modify Kartheus to form the wrap as two sheets welded together as taught by Frajderrajch to simplify construction with the outer sheet non-extensible to direct the expanding bladder inward toward the foot. It is noted that Kartheus teaches a first tab 45a for releasably securing the foot warp around the arch and a second tab 44a for releasably securing the foot warp around the heel. Also taught is a third tab 45b opposite the first tab.

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☎ (703) 308-3713
Fax: (703) 305-3590
danton.demille@uspto.gov


Danton DeMille
Primary Examiner
Art Unit 3764